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10/584,691

05/22/2007

Frank Henglein

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EXAMINER

SHEH, ANTHONY H

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/21/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/584,691	<b>Applicant(s)</b> HENGLEIN ET AL.	
	<b>Examiner</b> ANTHONY H. SHEH	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8 May 2009; 13 Sept 2007; 23 June 2006</u> .                  | 6) <input type="checkbox"/> Other: _____                          |



## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 11, 14, 17, 22, 26, 27, 28-34, 35-38, 40, 41, 43, 44, 52 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by CAMELON et al. (US 3932347, hereafter '347).

3. '347 discloses a powder coating composition wherein metal particles are used a coloring agent (Abstract). The metal particles are encapsulated in a thermosettable binder, which may be the same as the organic material use as a film-former of the powder coating (Abstract; col. 3, ln. 35-44). Said binder is a chemically crosslinkable polymer or copolymer (col. 4, ln. 42-45).

4. Regarding claims 1 and 2, in one embodiment, the coated metal particles (aluminum flakes - col. 11, ln. 32) are sieved such that the maximum diameter of said particles is less than 45 microns, which necessitates an average particle diameter ( $d_{50}$ ) lower than 45 microns. Furthermore, the entire powder coating composition (which includes said coated metal particles) is sieved through a 200 mesh screen, which forces a maximum particle diameter to be less than 69 microns (col. 12, ln. 13).

5. Regarding claim 3, '347 discloses that the metal particles (aluminum flakes - col. 3, ln. 56-57) are utilized in an amount between 2 and 200 wt.% of the binder (col. 3, ln. 57), i.e. the binder is contained in an amount between 33 and 98 wt.%, which substantially overlaps the claimed range. Preferably, the binder is contained in amount between 30 to 70 parts by weight (pbw) per 100 pbw of metal particle (aluminum - col. 4, ln. 1-3), i.e. between 23 and 44 wt.%.

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6. Regarding claims 4-7 and 16, '347 contemplates use of further additives and/or auxiliaries such as dyes (pthalo green pigment - col. 12, ln. 5), inorganic colored pigments (yellow iron oxide pigment - col. 12, ln. 6), polymerization initiators (AIBN - col. 10, ln. 63), catalysts (col. 6, ln. 67), curing agents (crosslinking agents - col. 4, ln. 45). In certain embodiments, the curing agent comprises glycidyl methacrylate (ex. 10; col. 16, ln. 35).

7. Regarding claim 11 and 14, '347 discloses that the binder may be thermosetting polymers such as polyesters, polyepoxides, urethane-containing polyesters (i.e. polyurethanes), and acrylics (col. 6, ln. 51-60).

8. Regarding claim 17, the reference specifically calls for thermosetting binders (col. 3, ln. 39), which by definition cure via thermal action, i.e. heating.

9. Regarding claim 22, '347 teaches that any particulate metal may be used, but the specific embodiment of the prior art composition comprises aluminum flakes (col. 3, ln. 25-34).

10. Regarding claim 26 and 52, the aluminum flakes may be embodied by aluminum paste (col. 4, ln. 23), in conjunction with an organic solvent e.g. mineral spirits (col. 4, ln. 25-26).

11. Regarding claim 27, the reference teaches a masterbatch having a high proportion of metal pigment (ex. 1 - col. 11, ln. 29-41).

12. Regarding claims 28-34 and 53, the powder coating composition cured via heating (col. 12, ln. 30-38), e.g. on automotive parts (col. 1, ln. 60), and is resistant to weathering (col. 12, ln. 35-38), i.e. corrosion. In an embodiment (ex. 1), the metal content is 1.65 wt.% (col. 12, ln. 16). In general, the metal content will be between 0.005 wt.% to 25 wt.% of the powder coating composition (col. 10, ln. 22-25), and depends on the desired application. As previously noted, the coating material of the metal particle and film-forming material of the powder coating composition are the same.

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13. Regarding claims 35-38, 40 and 41, '347 discloses a method of making said binder-coated metal particles (ex. 1) wherein a solution of polymeric binder (epoxy-functional acrylic copolymer) is prepared (col. 10, ln. 1-70; col. 11, ln. 1-18) in an organic solvent (methylene chloride - col. 11, ln. 38). The metallic particles (aluminum flakes in the form of aluminum paste - col. 11, ln. 30-33) are then dispersed in the solution and then spray dried (col. 11, ln. 42-48). After spray drying, the metal particles coated with binder are sieved (col. 9, ln. 11-15). In several embodiments, preparation of the binder solution contains a curing catalyst (AIBN - col. 10, ln. 63), prior to being combined with the metallic particles.
14. Regarding claims 43 and 44, as previously discussed, the '347 powder coating comprises said coated metallic particles.

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***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. The U.S. Supreme Court supplied seven rationales in *KSR International v. Teleflex Inc.* (550 USPQ2d 1385) that, by following the factual inquiries set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), establish a *prima facie* case of obviousness. The rationales are:

- (a) Combining prior art elements according to known methods to yield predictable results;
- (b) Simple substitution of one known element for another to obtain predictable results;
- (c) Use of a known technique to improve similar devices, methods, or products in the same way;
- (d) Applying a known technique to a known device, method, or product ready for improvement to yield predictable results;
- (e) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (f) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (g) Some teaching, suggestion, or motivation to combine prior art references that would have led one of ordinary skill to modify the prior reference teachings to arrive at the claimed invention.

18. The Examiner notes that above rationales are merely exemplary. For more information, see MPEP § 2141.

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19. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20. Claims 1-7, 11, 14, 17, 22, 26, 27, 28-34, 35-38, 40, 41, 43, 44, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over CAMELON et al. (US 3932347, hereafter '347).

21. The discussion of '347 above is incorporated herein by reference. If not found anticipatory, the cited claims are obvious as the reference enables one of ordinary skill in the art at the time of the instant invention to practice an invention within the scope of said claims.

22. Regarding claims 35-38, 40 and 41, it is noted that any order of mixing ingredients is *prima facie* obvious. *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930), see MPEP § 2144.04. Furthermore, selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946).

23. Claims 8-10, 25 and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over CAMELON et al. (US 3932347, hereafter '347) as applied to claims 1-7, 11, 14, 17, 22, 26, 27, 28-34, 35-38, 40, 41, 43, 44, 52 and 53 above, and further in view of KAUPP et al. (US 2002/0168484 A1, hereafter '484).



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24. '347 remains as applied above, however the reference does not teach priming of the metal particles. While the reference contemplates metallic pigments in general (col. 3, ln. 25-32), the only specific embodiment thereof are aluminum flake pigments.

25. Regarding claims 8-10 and 46-49, '484 discloses that aluminum flake pigments (para. [0003]) may be coated with passivation layers that prevent corrosion (para. [0011]). The passivation layers have several embodiments, including crosslinked organic polymer layers (para. [0018]) formed via radical polymerization, phosphonic/phosphoric acids having up to 20 carbon atoms and salts thereof para. [0015]), phosphates (ex. 3 - para. [0044]), phosphoric acid esters (clm. 1), and organophosphorous compounds (para. [0063]), metal oxide layers (para. [0016]) and silicates (para. [0016]).

26. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to coat the metal particles of '347 with the passivation layers of '484 under KSR rationales (c) or (d); the passivation layers improve the corrosion characteristics of said pigments, i.e. prevention thereof ('484: para. [0006]).

27. Regarding claim 25, the '484 aluminum flake pigment is an interference pigment (para. [0002]), comprising multiple layers of aluminum and silica (para. [0021], [0033]-[0037]).

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the interference pigment of '484 as the metal particle pigment of '347 under KSR rationales (b), (c), and (g); '347 suggests the use a variety of metallic pigments, as noted previously, while the interference pigments of '484 possess special optical properties (para. [0002]) e.g. angle-dependent shade variations.

(a) Claims 12-14, 16, 18-21, 39, 50 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over CAMELON et al. (US 3932347, hereafter '347) as applied to claims 1-7, 11,

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14, 17, 22, 26, 27, 28-34, 35-38, 40, 41, 43, 44, 52 and 53 above, and further in view of ROBINSON et al. (WO 00/22053, with US 7244780, hereafter '780, as an equivalent), taken with evidence from ARALDITE® GT 6063 Product Specification.

29. '347 remains as applied above. However, the reference does not teach corrosion inhibitors. While the reference contemplates a variety of film-forming binders, it is non-specific regarding said binders.

30. Regarding claims 12-14, 16 and 50, '780 further discloses as binders of the powder coating composition, carboxy-functional polyester resins, hydroxyl-functional polyester resins, epoxy resins, and functional acrylic resins (col. 8, ln. 9-14). The carboxy-functional polyester resin has acid number between 10 and 100 (col. 8, ln. 21), and may be used in a conjunction with a curing/crosslinking agent such as triglycidyl isocyanurate (col. 8, ln. 26). As epoxy resin, an embodiment of which is ARALDITE® GT 6063 having an epoxy equivalent weight between 640-730 (ex. 4; col. 15, ln. 60-65); epoxy resins can be cured using an amine-functional curing agent e.g. dicyandiamide (col.8, ln. 44-45). The reference teaches polyurethanes; a hydroxy-functional polyester combined with a blocked isocyanate-functional resin (col. 8, ln. 32-36).

31. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize as the thermosetting film-forming binder of '347, the binders of '780 under KSR rationales (a), (b), and (g); '347 suggests the use of organic, thermosetting film-forming materials which are self-crosslinkable or chemically-functional polymers with crosslinking agent (col. 3, ln. 38-41) to coat metal particle pigments, and '780 teaches specific embodiments thereof.

32. Regarding claims 18-21, 39 and 54, '780 discloses a powder coating composition (Abstract) which comprising a stabilizing additive (col. 1, ln. 43-45) and metallic pigments, e.g. aluminum flake pigment (col. 1, ln. 65-67). The stabilizing additives may added at any time

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during a homogenization process of the powder coating composition (col. 6, ln. 45-64), which includes a film-forming binder (col. 7, ln. 62-67), or to pre-treat said particles with the additive (col. 3, ln. 7-10). The stabilizing additives are anticorrosion agents (col. 1, ln. 56-64), having particle size between 0.1 and 10 microns (col. 7, ln. 32-37), embodied by strontium aluminum polyphosphate hydrates (col. 5, ln. 20-21), zinc phosphate (col. 5, ln. 4), organophosphonates (col. 5, ln. 50), and zinc molybdates (col. 5, ln. 51).

33. Therefore it would have been obvious to one of ordinary skill in the art at the time of the instant invention to include in the binder of '347, the anticorrosion agents of '780 under KSR rationales (c) and (d); the anticorrosion agents prevent weathering of the metallic pigments due to oxygen and water ('780: col. 1, ln. 61). Furthermore, the reference discloses that the anticorrosion agents can be added without restriction to a homogenization process. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to add said agents to either (1) the metal pigment powder component, or (2) the non-metal powder component of the '347 method, or to (3) pre-treat the '347 metal particles as instructed by '780 to achieve anticorrosive properties under the given KSR rationales. It is noted that any order of mixing ingredients is *prima facie* obvious. *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930), see MPEP § 2144.04.

34. Claims 15 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over CAMELON et al. (US 3932347, hereafter '347) as applied to claims 1-7, 11, 14, 17, 22, 26, 27, 28-34, 35-38, 40, 41, 43, 44, 52 and 53 above, and further in view of BAYARDS et al. (US 6291581, hereafter '581)

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35. '347 remains as applied above. While the reference contemplates a variety of film-forming binders, it is non-specific regarding said binders. In particular, the reference does not teach UV-curable binders.

36. '581 teaches binders for powder coating compositions that comprise unsaturated polyesters and polyacrylates (col. 1, ln. 64-65). The crosslinker may be variously embodied by a functional prepolymer e.g. and epoxy-functional prepolymers. The binder is curable by exposure to UV radiation (col. 6, ln. 43) in combination with photoinitiators (col. 6, ln. 43-46).

37. Therefore it would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the UV-curable binder of '581 as the film-forming binder of '347 under KSR rationales (b), (c) and (g); the binder of '581 predictably imparts a new feature into the powder coating of '347, i.e. the ability to be cured by exposure to sunlight rather than heat. The UV-curable powder coating composition of '347 in view of '581 is suitable as a nail varnish that does not necessitate drying with toxic fumes.

38. Claims 23, 24 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over CAMELON et al. (US 3932347, hereafter '347) as applied to claims 1-7, 11, 14, 17, 22, 26, 27, 28-34, 35-38, 40, 41, 43, 44, 52 and 53 above, and further in view of REISSER et al. (US 5964936, hereafter '936).

39. '347 remains as applied above. While the reference contemplates metallic pigments in general (col. 3, ln. 25-32), the only specific embodiment thereof are aluminum flake pigments.

40. '936 discloses oxidized pigments (Abstract) which comprise at most 90 wt.% aluminum. The pigment is suitably a metal flake pigment (col. 3, ln. 1-7). The oxidation process of said pigments is aqueous (col. 3, ln. 23-26), and as alloying constituents of said oxidized pigments are (e.g.) copper and zinc (col. 5, ln. 5-9).

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41. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the oxidized aluminum pigments of '936 as the metal pigment particles of '347 under KSR rationales (b), (c) and (g); '347 suggests the use a variety of metallic pigments, as noted previously, and '946 discloses that said pigments are capable of a variety of shades which are attributable to said alloying metal (col. 5, ln. 4-9).

42. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over CAMELON et al. (US 3932347, hereafter '347) as applied to claim 1-7, 11, 14, 17, 22, 26, 27, 28-34, 35-38, 40, 41, 43, 44, 52 and 53 above, and further in view of MORGAN et al. (US 5319001, hereafter '001).

43. '347 remains as applied above. However, the reference only discloses spray drying as a method of making coated metal pigments, and does not address wherein the coating and drying are performed in a fluidized bed.

44. '001 discloses a method of forming powder coating compositions (Abstract). The method of '001 utilizes a fluidized bed apparatus (Fig. 4; col. 9, ln. 51-55). Powders are fed into the fluidized bed and then a granulating agent is added from a spray head (ex. 3; col. 11, ln. 44-60). The mixing and fluidization dry the granulating agent-coated powders.

45. Therefore it would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the coating and drying of the metallic pigments of '347 by utilizing the method and apparatus of '001 under KSR rationale (b); both methods are known in the art as equivalent means to obtain coated powder materials. The method of '347 in view of '001, as interpreted by one of ordinary skill in the art at the time of the instant invention, would entail placing the metallic pigment in the fluidized bed, and applying the binder preparation from the spray head, following by sieving.

### ***Double Patenting***

46. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

47. Claims 1, 8, 9, 25, and 46-49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 7, 8, 11 and 12 of U.S. Patent No. 6,287,695 (hereafter ‘695) in view of CAMELON et al. (US 3932347, hereafter ‘347).

48. ‘695 claims passivation layer-coated aluminum-based metallic pigment (clm. 1). Said pigment is suitably an interference pigment having multiple layers of opaque and transparent aluminum and low-refractive index dielectric (clm. 3). The passivation layer comprises at least one of phosphoric/phosphonic acids and derivatives thereof having 8-20 carbon atoms, metal oxide layers, and crosslinked polymers, e.g. acrylates (clm. 7, 8, 11, 12).

49. However the reference does not disclose coating said passivation-layer containing aluminum-based metallic pigments with a polymeric binding agent.

50. ‘347 discloses a powder coating composition wherein metal particles are used a coloring agent (Abstract). The metal particles are encapsulated in a thermosettable binder, i.e. polymeric

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binding agent, which may be the same as the organic material use as a film-former of the powder coating (Abstract; col. 3, ln. 35-44). Said binder is a chemically crosslinkable polymer or copolymer (col. 4, ln. 42-45).

51. Therefore, it would have been obvious to one of ordinary skill at the time of the instant invention to coat the pigments of '695 with the binder of '347 to form a powder coating composition which cures without volatile solvent evaporation and has utility in coating various articles e.g. automobile parts, under KSR rationale (c), (d) and (g); '347 suggests the use a variety of metallic pigments (col. 3, ln. 25-32) and forming powder coatings comprising the '695 pigments improves their utility in a known fashion.

52. Claims 1, 8, 9, 25, and 46-49 directed to an invention not patentably distinct from claim 1, 3, 4, 7, 8, 11 and 12 of commonly assigned U.S. Patent No. 6,287,695 (hereafter '695). Specifically, see paragraphs 47-51 above.

53. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned '695, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

54. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the

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commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

55. Claims 1, 8, 9, 25, and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over KAUPP et al. (US 6287695 B1, hereafter '695) in view of CAMELON et al. (US 3932347, hereafter '347). For explanation, see paragraphs 48-51, above.

### ***Conclusion***

56. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTHONY H. SHEH whose telephone number is (571) 270-7746. The examiner can normally be reached on Mondays through Thursdays, 9:30A-3:30P.

57. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VASUDEVAN S. JAGANNATHAN can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

58. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ANTHONY H SHEH/  
Examiner, Art Unit 1796



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/Vasu Jagannathan/

Supervisory Patent Examiner, Art Unit 1796